

### REMARKS/ARGUMENTS

Entry of this response and reconsideration and allowance of the above-identified patent application are respectfully requested. Claims 1-25 were rejected in the office action. Upon entry of this amendment and response, claims 1-25 will be pending in the application. No new matter has been added, and no additional prior art searches are required by the amendments.

In the official action, claims 1-25 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Muntz *et al.* (U.S. Patent No. 5,896,427) ("Muntz") in combination of Khasnabish (U.S. Patent No. 6,411,679). Applicants respectfully assert that claims 1-25 are distinguished over the teachings of Muntz and Khasnabish for the reasons given below.

The present invention provides, *inter alia*, a novel method for testing a communication network using a first clock and a second clock that operate from a substantially similar reference. Briefly, the novel method transmits a first signal from a first point to a remotely located second point. In the novel method, a first clock time stamps the signal as it is transmitted from the first point, and a second clock time stamps the signal as it is received at the second point. Furthermore, as now amended, claim 1 recites that a performance characteristic (*e.g.*, signal delay, signal distortion, signal duplication, signal intensity, and signal-to-noise ratio) is determined based on a comparison of the time stamps associated with the first and second signals.

As acknowledged by the office action, "Muntz does not explicitly show *testing a communication network.*" (*Office Action dated February 10, 2003 at p.3*) (emphasis added). The office action contends that although Muntz describes the elements previously recited in claim 1 of the present invention, its lack of express teaching of testing a communication

network is overcome by the combination of Khasnabish's teaching of testing a communication network.

As is well known, in order to combine Muntz with Khasnabish, there must be some motivation to combine the references to meet the claimed present invention. More specifically, "there must be some teaching, suggestion or motivation in the prior art to make the specific combination that was made by the applicant." *In re Oetiker*, 24 USPQ2d (BNA) 1443, 1445 (Fed. Cir. 1992). "In other words, the examiner must show reasons that the skilled artisan, confronted with the same problem as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." *In re Rouffet*, 47 USPQ2d (BNA) 1453, 1458 (Fed. Cir. 1998).

There is no motivation in either Muntz or Khasnabish to combine Muntz with Khasnabish's testing of a communication network. Quite the contrary, Muntz is focused on accomplishing network synchronization, and Khasnabish is directed to calculating an *elapsed* time between sending and receiving a signal. Neither reference provides the necessary motivation to combine. Specifically, Muntz does not teach, suggest or provide any motivation to apply its network synchronization to the present invention's testing of communication networks. Similarly, Khasnabish does not teach, suggest or provide any motivation to apply its method of send and receive-based testing to the present invention's novel method of testing.

In fact, Khasnabish teaches away from any such motivation by disclosing a testing method that uses a single clock to "calculate an elapsed time between sending the signal and receiving *a response to the signal*." (*Khasnabish* – column 1, lines 56-60) (emphasis added).

More specifically, Khasnabish has a first device that sends a signal to a second device. The first device then waits for a response from the second device and adjusts an answer tone accordingly. (*Khasnabish* – column 1, lines 55-58). In other words, Khasnabish records the transmission time and the reception time using a single clock. Khasnabish does not, therefore, provide any motivation for combining its testing of a communication network with the methods described in Muntz.

Similarly, Muntz applies its methods to “maintaining network synchronization.” (*Muntz* – Title). As the office action itself reflects, maintaining network synchronization is different than testing a communication network. Muntz itself notes that maintaining network synchronization is necessary to overcome “an increased loss of data due to the difference in phase and frequency between the node’s local and reference clocks.” (*Muntz* – column 3, lines 33-36). The office action acknowledges that Muntz does not expressly show testing of a communication network. However, the office action suggests that “one of minimum skill in the art would readily recognize that some sort of ‘testing’ would be required to ensure that data would not be lost.” (*Office Action dated February 10, 2003* at p. 6-7). However, the examiner is respectfully requested to recognize that the even stretching an interpretation of Muntz to the sort of testing of results that likely exists with any invention is not the same as, and certainly does not provide a motivation for, the testing of the present invention that involves determining performance characteristics (*e.g.*, signal delay, signal distortion, signal duplication, signal intensity, and signal-to-noise ratio) by comparing the time stamps associated with the first and second signals.

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**PATENT**

Accordingly, withdrawal of the rejection of claims 1-25 under 35 U.S.C. §103(a) as being obvious over Muntz in view of Khasnabish is believed proper and respectfully solicited.

### **CONCLUSION**

In view of the foregoing, applicants respectfully submit that the present application is in condition for allowance. Reconsideration of the application and an early Notice of Allowance are respectfully requested. In the event that the Examiner cannot allow the present application for any reason, the Examiner is encouraged to contact the undersigned attorney, Vincent J. Roccia at (215) 564-8946, to discuss resolution of any remaining issues.

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